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Remarks

Reconsideration of remaining claims 1-4 is respectfully requested.

In the Office action dated July 27, 2004 (application Paper No. 3), the Examiner objected to the specification and abstract, and rejected the pending claims under 35 USC §§ 102(b) and 103(a). The Examiner's objections and rejections will be discussed below in the order appearing in the Office action.

Specification Objection

The Examiner first objected to the specification, citing a typographical error at line 10 of page 2. As noted above, applicant has amended the pertinent paragraph of the specification so as to now read "*carrier's*" at line 10. The specification should now be in conformance with the MPEP requirements. The Examiner then objected to the Abstract in that it contained more than 150 words. In response, applicants have amended the Abstract, in the manner indicated above, to now contain less than 150 words. Applicants believe that this amended Abstract should now be in compliance with the requirements of MPEP § 608.01(b).

35 USC § 102(b) Rejection – Claims 1 and 4

The Examiner first rejected claims 1 and 4 under 35 USC 102(b) as being anticipated by US Published Application 2002/0098834 (Yuen). In the rejection, the Examiner cited Yuen as teaching "a method of connecting telephone services to a digital TV set-top box. Yuen discloses a process by which the system scans for and then synchronizes with the downstream channel, in a process that is initiated by the set-top box".

In response, applicant asserts that Yuen does not disclose, suggest or anticipate any method or system for implementing "user chosen" telephone services through a digital cable TV set-top box, as defined in amended claims 1 and 4. In particular, a set-top box of the present invention is connected, via a cable network, to a cable "headend". The headend is also connected to a conventional telephone network. By communicating

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between the set-top box and the telephone network, a user is given the ability to “select” telephone services that are then “downloaded” and stored in his set-top box for later use.

In contrast, Yuen is related to using a telephone connection (in an upstream fashion, not downstream), to complete a “pay per view”, or “home shopping” transaction, where the transaction was initiated by a cable-provided television program. There is no discussion or reference in Yuen to implementing “telephone services” by code that is downloaded to a set-top box, which is precisely the subject matter of the present invention. Indeed, Yuen requires the simultaneous use of both the telephone network and the cable network. The intent of the present invention is to merge the two; providing telephone services over the cable network.

In light of the amendments to independent claims 1 and 4, as well as the above arguments, applicant believes that Yuen cannot be found to “anticipate” the subject matter of the present invention, as required by 35 USC 102(b). Applicant therefore respectfully requests the Examiner to reconsider this rejection and find claims 1 and 4, as amended, to now be in condition for allowance.

35 USC § 102(b) Rejection – Claim 5

Claim 5 was next rejected by the Examiner under 35 USC 102(b) as being anticipated by US Patent 6,219,355 (Brodigan). Inasmuch as applicant has cancelled claim 5, there is no need to further address this rejection.

35 USC § 103(a) Rejection – Claims 2 and 3

Lastly, the Examiner rejected claims 2 and 3 under 35 USC 103(a) as being unpatentable over Yuen in further view of US Published Application 2002/0075231 (Martino). The Examiner cited Martino as teaching the use of “removable storage medium” in an arrangement similar to Yuen.

Regardless of the teaching of Martino, applicant asserts that the combination of Yuen and Martino still lacks any teaching of implementing “user-chosen” telephone services via a set-top box, where the user selects the desired services and the necessary software is downloaded over a cable network to the set-top box. Without this teaching, it is asserted that claims 2 and 3 (as depending from claim 1) cannot be found to be

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rendered obvious. Applicant thus respectfully requests the Examiner to reconsider this rejection and find claims 2 and 3 to be in condition for allowance.

Based on the amendments to claims 1 and 4, as well as the above arguments, applicant asserts that the remaining claims are now allowable over the cited references. Applicant therefore respectfully requests the Examiner to reconsider these rejections and find claims 1-4 to be in condition for allowance. If for some reason or other the Examiner does not agree that the case is ready to issue and that an interview or telephone conversation would further the prosecution, the Examiner is invited to contact applicant's attorney at the telephone number listed below.

Respectfully submitted,

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